

REMARKS

This is in full and timely response to the non-final Office Action mailed on December 19, 2003. Reexamination in light of the amendments and the following remarks is respectfully requested.

Claims 1-14 are currently pending in this application, with claims 1 and 2 being independent. No new matter has been added.

Rejection under 35 U.S.C. §112

Claim 2 was rejected under 35 U.S.C. §112, first paragraph as lacking enablement.

This rejection is traversed at least for the following reasons.

This rejection is traversed at least for the following reasons. 35 U.S.C. §112 "requires only an objective enablement; the invention needs to be sufficiently disclosed through illustrative examples or terminology to teach those of ordinary skill in the art how to make and how to use the invention as broadly as it is claimed" (emphasis added). *Musco Corp. v. Qualite Inc.*, 41 USPQ2d 1954 (Fed. Cir. 1997). See also M.P.E.P §§2164.01, 2164.04.

In addition, "for claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims." *General Electric Co. v. Nintendo Co.*, 50 USPQ2d 1910, 1914 (Fed. Cir. 1999).

The Office Action contends that a wireless connection is not found within the specification as originally filed. In response to this contention, the specification as originally filed, at for example, page 6, lines 13-16, provides that "electrical communication between the controlling interface and the electronic device can be at least in part carried out by way of wireless communication."

No prior art has been cited against claim 2. Moreover, claim 2 has been placed into independent form. If the allowance of claim 2 is not forthcoming at the very least and a new grounds of rejection made, then a new non-final Office Action is respectfully requested. See M.P.E.P §706.07(c).

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Claims 1-8 were rejected under 35 U.S.C. §112, second

paragraph.

The Office Action contends that "said user" found within claim 1 as originally filed lacks an antecedent basis.

In response to this contention, while not conceding the propriety of this rejection and to advance the prosecution of the above-identified application, claim 1 has been amended by replacing "said user" with -- a user --.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Rejection under 35 U.S.C. §102 and §103

Claims 1, 3 and 7 were rejected under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 5,059,970 to Raubenheimer et al. (Raubenheimer), or U.S. Patent No. 5,528,248 to Steiner et al. (Steiner), U.S. Patent No. 6,442,637 to Hawkins et al. (Hawkins).

Claim 8 was rejected under 35 U.S.C. §102 as allegedly being anticipated by Raubenheimer or Steiner.

Claims 4-6 were rejected under 35 U.S.C. §103 as allegedly

being obvious over U.S. Patent No. 5,497,339 to Bernard, or over Hawkins in view of Bernard.

These rejections are traversed at least for the following reasons.

Claim 1 and the claims dependent thereon are drawn to a case for an electronic device that includes:

a first protective material that maintains said electronic device within said case; and

at least one controlling interface, in electrical communication with said electronic device, and disposed on said first protective material, through which a user can operate an electronic feature of said electronic device,

wherein said controlling interface is used as an upgraded set of controls.

Hawkins arguably teaches an expandable mobile computer system having controls 130 (figure 1A). In addition, Hawkins arguably teaches that other user interface elements such as buttons may be placed that front surface of the MP3 peripheral

device 300 (figure 3, column 4, lines 29-30).

Nevertheless, Hawkins fails to disclose, teach or suggest a controlling interface used as an upgraded set of controls.

Raubenheimer arguably teaches a navigational aid having an alphanumeric keyboard 14 (figure 1). However, Raubenheimer fails to disclose, teach or suggest a controlling interface used as an upgraded set of controls.

Steiner arguably teaches a personal digital location assistant including a memory cartridge, a GPS smart antenna and a personal computing device. Yet, Steiner fails to disclose, teach or suggest a controlling interface used as an upgraded set of controls.

Bernard arguably teaches a portable apparatus for providing multiple integrated communication media having a communication device 100 (figure 2). But Bernard fails to disclose, teach or suggest a controlling interface on the communication device 100 that is used as an upgraded set of controls.

Withdrawal of these rejections and allowance of the claims is respectfully requested.

Conclusion

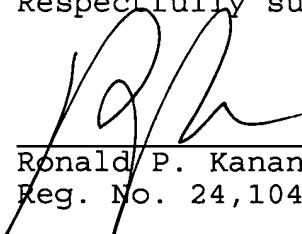
For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753 or the undersigned attorney at the below-listed number.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Respectfully submitted,

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